

Appl. No. 10/071,376
Amendment transmitted on September 8, 2005
Reply to Office action of July 14, 2005

REMARKS

Claims 1-3, 5-8, and 10-16 are pending in the present application.

Rejections under 35 U.S.C. §112

The Examiner rejected claim 2 under 35 U.S.C. §112, second paragraph.

Specifically, the Examiner objects to the use of the alternative claim language for the series of alternative ranges recited for the thickness of the solid hardwood component. By the present amendment these alternative ranges have been deleted from claim 2.

The Present Invention

The present application relates to a laminated wood piece, a door including the laminated wood piece in the form of a stile member, and methods for manufacturing a door including the laminated wood piece as a door stile. The laminated wood piece comprises a solid hardwood component having an upper surface and a lower surface that are substantially parallel to each other; and a wood composite component having layers oriented substantially parallel to the lower surface of the solid hardwood component. The ratio of a thickness of the solid hardwood component to a thickness of the wood composite component is from about 1:1 to about 1:10.

As mentioned above, the laminated wood piece may be installed as a stile in a composite door so that the wood composite component faces inwardly towards the center of the door, and the solid hardwood component is on the outer side of the wood composite component to give the edge of the door a pleasing and attractive finish that preferably matches the wood grain of the surface skin veneers. (Specification, Paragraph 0010).

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Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 1-3 and 5-8 under 35 U.S.C. §103 as being unpatentable over Iwata. The Examiner argues that Iwata discloses "the basic inventive concept" of the present claims, however, the Examiner concedes that Iwata fails to disclose several elements of the present claims, including (1) the dimensions of the thickness of the hardwood, (2) the width and the (3) length of the wood piece, (4) the screw holding strength, and the (5) split resistance strength, but nonetheless, contends, citing to *In re Aller*, 15 U.S.P.Q. 233 (C.C.P.A. 1955), that these thickness, length, width, screw holding strength, and split resistance strength ranges recited in the present claims would have been obvious because, "it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See in re Aller, 15 U.S.P.Q. at 233."

Applicants respectfully disagree with the Examiner's analysis because the Examiner has not made the necessary factual findings to support the use of *Aller*. *Aller* concerned a process patent application. In *Aller* the Examiner identified a known relationship in the prior art between a set of processing parameters and the process efficiency, and the Examiner further showed that this known relationship demonstrated that the claims on appeal merely reflected the results of expected optimization of the disclosed set of parameters. (105 U.S.P.Q. at 234-35). In the present case, the Examiner has made no such showing. In fact, rather than make any such showings, it appears that in the Office Action of November 18, 2003, the Examiner merely recites the holding of the *Aller* case, without applying its holding to the facts of the

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present application, and asserts that all elements of the claims that are not specifically taught by Iwata could be obtained by a person of ordinary skill in the art through routine optimization.

Indeed, the Examiner has not shown that Iwata has any teaching that would have motivated a person of ordinary skill to optimize the thickness, length, width, screw holding strength, and split resistance strength. Merely because Iwata discloses composite wood boards does not make it obvious to optimize the composite wood board in the manner suggested by the Examiner. By contrast, in *Aller*, the prior art reference disclosed a relationship between certain processing parameters and the process efficiency. Accordingly, Applicants believe that the Examiner has not appropriately applied *Aller* with respect to the present application.

In response to the above arguments regarding *Aller*, the Examiner has responded that:

[Applicants arguments are] unpersuasive in that the dimensions are merely design selections, the ranges of which are merely expected optimizations of the device and according to *Aller* would be an obvious rendition of the device. Therefore, this argument is unpersuasive. (Office Action of July

14, 2005, page 7).

Applicants disagree with the Examiner's response on at least three separate grounds. First, the Examiner has not explained why a case which was decided based on specific facts relating to a chemical process patent, should be broadened to apply to a patent application pertaining to a composite wood piece. Second, even assuming, *in arguendo*, that it is appropriate to apply *Aller* to the facts of the present case, the Examiner has relied on conclusory statements, rather than making the necessary showing described in *Aller*. As Applicants have reiterated several times previously, the *Aller* Examiner identified a known relationship in the prior art between a set of processing parameters and the process efficiency, and the *Aller*

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Examiner further showed that this known relationship demonstrated that the claims on appeal merely reflected the results of expected optimization of the set of parameters that had been disclosed in the prior art.

The Examiner has made no such showings here. Instead the Examiner has merely stated, without further support, that these elements of the present claims are merely design selections, which a person of ordinary skill in the art would expect to be able to optimize.

Third, several elements of the present claims are beyond the scope of Aller, because they are not design characteristics, or structural aspects of the present claimed composite wood piece at all. For example claim elements like the screw holding strength, and the split resistance strength are patentable aspects of the material, not design elements that can be readily modified by a person of ordinary skill in the art.

Therefore, based on the above remarks, the Examiner has failed to establish that the present claims are obvious in view of Iwata. Reconsideration and withdrawal of the rejections of these claims are respectfully requested.

The Examiner has rejected claim 9 under 35 U.S.C. §103 as being unpatentable over Iwata in view of U.S. Patent Application 2003/0008110 A1 to Hsu ("Hsu").

While Applicants strenuously disagree with the Examiner's conclusions in this rejection, Applicants submit that this rejection is now moot because claim 9 has been deleted from the present application.

The Examiner has rejected claims 10-16 under 35 U.S.C. §103 as being unpatentable over West, U.S. Patent No. 6,092,343 ("West") in view of Iwata, U.S. Patent No. 5,554,429 ("Iwata"). West discloses a composite door prepared with a skin composed of a

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molding compound, the molding compound containing a resin system of a curable polyester resin, a co-curable unsaturated resin monomer and at least two low profile additives. (Col. 2, lines 40-52). This molding composition also includes at least about 30% (by weight of the overall molding compound) and less than about 35% of fibrous reinforcement. (Id.). West discloses that this skin is used in combination with a standard composite door configuration including a core positioned in a frame, the frame composed of multiple stiles and rails. (Col. 3, lines 17-23 and lined 50- 65). These door parts are typically made from wood materials. (Id.). A skin is attached to each side of the frame. (Col. 4, lines 7-16). The Examiner applies West to teach "the basic inventive concept" of the elements of the door. The Examiner concedes that West fails to teach several elements of the present claims including: (1) the "specific of the core"; (2) a stile having the hardwood and parallel layers of wood composite; (3) the wood composite layers contacting the core; (4) the method of cutting the wood composite and the hardwood into the desired dimensions; and (5) attaching all of these sections together, with both having the same width.

The Examiner applies Iwata to teach these missing elements, but concedes that Iwata fails to disclose several of the missing elements. Nonetheless, the Examiner maintains that these elements would be obvious to one of ordinary skill in the art in view of:

it would have been obvious to one of ordinary skill in the art at the time of the invention from the teaching of Iwata et al. to have used a core [sic] Iwata et al. in order to have the desired strength of the door. The method cutting the wood composite and hardwood of the same width and attaching them together would also be an obvious way to make the device, and when assembled the method of having the wood composite touch the core would also be obvious, since that configuration would include facing the more aesthetically pleasing hardwood to the eye of the user.

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The Examiner's reasoning is difficult to follow, and at times appears to be swallowed up in a typographical error, but it again appears that the Examiner has failed to make a sufficient case that the present claims would be obvious in view of the combination of West and Iwata. Specifically, rather than identify statements in the applied references that would have motivated a person of ordinary skill in the art to modify and combine the references in the manner the Examiner is suggesting, the Examiner makes retrospective statements that are indicative of hindsight reconstruction. Even assuming that there was sufficient teachings that would have motivated a person of ordinary skill in the art to modify and combine the references, the Examiner has not demonstrated that the combination of Iwata and West discloses all of the elements of the present claims.

Therefore, based on the above remarks, the Examiner has failed to establish that the present claims are obvious in view of West and Iwata. Reconsideration and withdrawal of the rejections of these claims are respectfully requested.

CONCLUSION

Reconsideration and withdrawal of the rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

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